

In the office action, the drawings and specification were objected to. A replacement paragraph and corrected formal drawing are provided herewith to overcome these objections. A marked up copy of the paragraph is also appended.

In the office action, the claim 1 was rejected under 35USC103 (a) as being obvious over Menashi 6265884 in view of Austin 6043742.

It is respectfully submitted that the invention as claimed in claim 1 is unobvious over the prior art for the following reasons:

- 50c 1. Claimed elements are absent from the combination indicated by the examiner as being disclosed in '88⁴ in background of the invention, (col.1, line, 66 through col. 2, line12)

To quote in its entirety:

"Electrical resistance measurements have been used to distinguish gems. In particular, some thermal testers have included a two electrode device for detecting when a thermal probe is erroneously in contact with a metal, which has a thermal conductivity very similar to that of natural diamonds. This prevented an operator from falsely identifying a gemstone as a diamond when, in fact, the measuring device was measuring the thermal conductivity of the metal instead of the gem. Occasionally, this low impedance detection circuit, when used correctly, could positively indicate that a gem under test was a member of a more conductive class of moissanite. The tester, however, was unsuccessful at identifying the balance of the moissanite gems that were less conductive."

This is a circuit that can only indicate a short circuit.

This is not the element of claim 1 e) "electrical conductivity display means mounted in the housing and connected to the electrical conductivity measuring assembly for displaying an indication of the electrical conductivity of the stone relative to the electrical conductivity of diamond".

If it were, then Examiner Glenn W. Brown would not have allowed the patent to Menashi, since it would have been an admission by the inventor in his own background statement of the existence of his invention in the prior art.

2. The Examiner indicates that it is obvious to combine the housing of '742 with the assembly of the background structure of '884. There has been no teaching or suggestion

to modify the prior art as suggested by the examiner, and the suggested combination would not work as intended.

Since the combinations lack elements of the claims, are opposite teaching, and do not function as intended, it is therefor unobvious. In re Clinton, 527 F. 2d, 188 USPQ365 (CCPA 1976)

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. In re Vaeck, 947 F.2d 488, USPQ 2d 1438 (Fed.Cir. 1991).

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

The showing of suggestion to combine must be clear and particular. Examiner has made no such showing. In re Dembiczak, 175 F.3d 994, 50 USPQ 2d. 1614 (Fed. Cir.1999).

In view of the foregoing, it is urged that the Examiner withdraw the rejections and allow the amended claims

Reconsideration is respectfully requested.

Respectfully submitted,

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